

### REMARKS/ARGUMENTS

Claims 1-4, 9-22, 27-40, and 45-54 are currently pending. Claims 1-4, 9-22, 27-40, and 45-54 stand rejected. Claims 5-8, 23-26, and 41-44 have been canceled herein. Claims 1-4, 19-22, and 37-40 have been amended and no new matter has been added. No new claims have been added. Applicants respectfully request reconsideration.

#### Rejection of Claims 1, 2, 5, 19, 20, 23, 37, 38 and 41 under 35 U.S.C. § 102(e)

Claims 1, 2, 5, 19, 20, 23, 37, 38 and 41 stand rejected under 35 U.S.C. § 102(e) as purportedly being anticipated by Vancillie et al. (U.S. Pat. No. 5,095,917; hereinafter referred to as "Vancillie"). In order to support a rejection under 35 U.S.C. § 102(e), the cited reference must disclose each and every element of the rejected claim. Vancillie does not disclose each and every element of Applicants' amended independent claims 1, 19 and 37, therefore Applicants traverse this rejection, at least for the following reasons.

Applicants have amended independent claims 1, 19 and 37 to recite, in relevant parts, "...applying a heating element in the form of a catheter-mounted RF electrode array." Support for these amendments can be found, at least, in dependent claims 3, 4, 21, 22, 39, 40 and in Applicants' specification at paragraphs [0040] – [0043].

Vancillie does not teach "...applying a heating element in the form of a catheter-mounted RF electrode array." Vancillie simply does not teach the use of RF energy (as also pointed out by the Office in the Action dated 2/21/08). Because Vancillie does not teach the use of RF energy, it certainly does not teach the use of a catheter-mounted *RF electrode array*, as taught by Applicants' amended independent claims 1, 19 and 37. Vancillie teaches a copper wire 33 for connection to a current generator via electrical cables 37. See col. 3, lines 1-5 and FIG. 2. Vancillie does not teach the use of more than one electrode and certainly does not teach the use of an *electrode array*, as recited by Applicants' amended independent claims 1, 19 and 37.

Because Vancillie does not teach all the limitations of Applicants' amended independent claims 1, 19 and 37, these claims are believed to be allowable over Vancillie. Dependent claims 2, 20 and 38 are believed to be allowable, at least, because they depend from allowable claim 1, 19 or 37. Because claims 5, 23 and 41 have been canceled, the rejection of these claims is now believed to be moot. Applicants respectfully request the rejection of claims 1, 2, 19, 20, 37 and 38 be withdrawn.

**Rejection of Claims 3, 4, 6-8, 21, 22, 24-26, 39, 40 and 42-44 under 35 U.S.C. § 103(a)**

Claims 3, 4, 6-8, 21, 22, 24-26, 39, 40 and 42-44 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Vancillie et al. (U.S. Pat. No. 5,095,917; hereinafter referred to as "Vancillie") in view of Makower et al. (U.S. Pat. No. 5,830,222; hereinafter referred to as "Makower"). In order to support a rejection under 35 U.S.C. § 103(a), the rejected claims must be obvious in light of the cited reference. Because Applicants' claims 3, 4, 6-8, 21, 22, 24-26, 39, 40 and 42-44 are not obvious in light of Vancillie or Makower, Applicants traverse this rejection, at least for the following reasons.

Applicants incorporate their above arguments with regard to claims 1, 19 and 37 and Vancillie, *supra*. Because claims 6-8, 24-26 and 42-44 have been canceled, the rejection of these claims is now believed to be moot, therefore only claims 3, 4, 21, 22, 39 and 40 will be addressed.

Vancillie teaches a method involving destruction of the mucosa followed by insertion of a biodegradable plug. The mucosal destruction provokes an inflammatory reaction and the plug serves as a substrate to guide the healing process toward occlusion instead of recanalization. See Abstract. Makower teaches a percutaneous means for revascularizing an organ fed by a diseased vessel. See col. 3, lines 10-45. Makower specifically teaches revascularization while Vancillie specifically teaches away from revascularization or recanalization by teaching "occlusion **instead of recanalization**." See Vancillie Abstract. While Vancillie teaches methods for occluding the uterotubal junction to block the pathway between the uterus and the ovaries, Makower teaches revascularizing or increasing blood flow to an organ. Applicants fail to see any motivation to combine these references, especially in light of the fact that Vancillie teaches methods for sterilization of a female while Makower teaches methods for use in the heart.

Applicants fail to see how one of ordinary skill in the art would be motivated to combine the Vancillie and Makower references. The obviousness rejection is based on hindsight from these disparate references to provide random elements of the claims. There is no clear, particular motivation in the references to reach the claimed invention. Since the Examiner has not presented evidence in the form of some teaching, suggestion, incentive or inference in the applied references that one having ordinary skill in the art would have been motivated to make the claimed invention, a *prima facie* case of obviousness has not been established. The Applicants respectfully request the withdrawal of the rejection of claims 3, 4, 21, 22, 39 and 40.

Because neither Vancillie nor Makower teach or suggest the limitations of amended independent claims 1, 19 and 37, Applicants' amended independent claims 1, 19 and 37 are believed to be allowable over the combined teachings of both Vancillie and Makower.

Dependent claims 3, 4, 21, 22, 39 and 40 are believed to be allowable, at least, because they depend from allowable amended independent claims 1, 19 or 37. Applicants respectfully request the rejections of claims 3, 4, 21, 22, 39 and 40 be withdrawn.

**Rejection of Claims 9, 10, 13, 17, 27, 28, 31, 35, 45, 46, 49 and 53 under 35 U.S.C. § 103(a)**

Claims 9, 10, 13, 17, 27, 28, 31, 35, 45, 46, 49 and 53 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Vancillie et al. (U.S. Pat. No. 5,095,917; hereinafter referred to as "Vancillie") in view of Zeluff et al. (U.S. Pat. No. 4,606,336; hereinafter referred to as "Zeluff"). In order to support a rejection under 35 U.S.C. § 103(a), the rejected claims must be obvious in light of the cited reference. Because Applicants' claims 9, 10, 13, 17, 27, 28, 31, 35, 45, 46, 49 and 53 are not obvious in light of Vancillie or Zeluff, Applicants traverse this rejection, at least for the following reasons.

Applicants incorporate their above arguments with regard to claims 1, 19 and 37 and Vancillie, *supra*. Zeluff teaches a permanent ostial occlusion device, while Vancillie teaches the use of a biodegradable plug. Because Zeluff teaches use of a permanent implant and Vancillie teaches the use of a biodegradable or temporary implant, Applicants fail to see the motivation to combine these references and further believe that these references teach away from one another. Additionally, Zeluff teaches an ostial occlusion device which forms a hermetic seal around the tubal ostium of the uterotubal junction. The hermetic seal taught by Zeluff may need to be created by the use of an adhesive to maintain the required contact between the occlusion device and the underlying tissues. See Abstract and col. 6, lines 5-10. Conversely, Vancillie teaches a method involving thermal damage of the tubal mucosa. See col. 3, lines 10-15. Because Vancillie teaches a method involving thermal application of energy, while Zeluff teaches a purely mechanical method, Applicants fail to see any motivation to combine these references.

Applicants fail to see how one of ordinary skill in the art would be motivated to combine the Vancillie and Zeluff references. The obviousness rejection is based on hindsight from these disparate references to provide random elements of the claims. There is no clear, particular motivation in the references to reach the claimed invention. Since the Examiner has not presented evidence in the form of some teaching, suggestion, incentive or inference in the applied references that one having ordinary skill in the art would have been motivated to make the claimed invention, a *prima facie* case of obviousness has not been established. The Applicants respectfully request the withdrawal of the rejection of claims 9, 10, 13, 17, 27, 28, 31, 35, 45, 46, 49 and 53.

Because neither Vancillie nor Zeluff teach or suggest the limitations of amended independent claims 1, 19 and 37, Applicants' amended independent claims 1, 19 and 37 are believed to be allowable over the combined teachings of both Vancillie and Zeluff. Dependent claims 9, 10, 13, 17, 27, 28, 31, 35, 45, 46, 49 and 53 are believed to be allowable, at least, because they depend from allowable amended independent claims 1, 19 or 37. Applicants respectfully request the rejections of claims 9, 10, 13, 17, 27, 28, 31, 35, 45, 46, 49 and 53 be withdrawn.

**Rejection of Claims 11, 12, 15, 16, 29, 30, 33, 34, 47, 48, 51 and 52 under 35 U.S.C. § 103(a)**

Claims 11, 12, 15, 16, 29, 30, 33, 34, 47, 48, 51 and 52 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Vancillie et al. (U.S. Pat. No. 5,095,917; hereinafter referred to as "Vancillie") in view of Zeluff et al. (U.S. Pat. No. 4,606,336; hereinafter referred to as "Zeluff") as applied to claims 9, 10, 27, 28, 45 and 46 above, and further in view of Barbacci (U.S. Pat. No. 5,531,741). In order to support a rejection under 35 U.S.C. § 103(a), the rejected claims must be obvious in light of the cited reference. Because Applicants' claims 11, 12, 15, 16, 29, 30, 33, 34, 47, 48, 51 and 52 are not obvious in light of Vancillie, Zeluff, or Barbacci, Applicants traverse this rejection, at least for the following reasons.

Applicants incorporate their above arguments with regard to claims 1, 19 and 37 and Vancillie, *supra*, as well as their above arguments with regard to Zeluff, *supra*. Because Vancillie and Zeluff teach away from one another, and because Barbacci does not teach that which is lacking from Vancillie and Zeluff, and because claims 11, 12, 15, 16, 29, 30, 33, 34, 47, 48, 51 and 52 depend from allowable amended independent claims 1, 19 and 37, Applicants respectfully assert that claims 11, 12, 15, 16, 29, 30, 33, 34, 47, 48, 51 and 52 are allowable over Vancillie, Zeluff, and Barbacci and request that this rejection be withdrawn.

**Rejection of Claims 14, 18, 32, 36, 50 and 54 under 35 U.S.C. § 103(a)**

Claims 14, 18, 32, 36, 50 and 54 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over Vancillie et al. (U.S. Pat. No. 5,095,917; hereinafter referred to as "Vancillie") in view of Zeluff et al. (U.S. Pat. No. 4,606,336; hereinafter referred to as "Zeluff") as applied to claims 9, 10, 27, 28, 45 and 46 above, and further in view of Brundin (U.S. Pat. No. 4,509,504). In order to support a rejection under 35 U.S.C. § 103(a), the rejected claims must be obvious in light of the cited reference. Because Applicants' claims 14, 18, 32, 36, 50 and 54 are not obvious in light of Vancillie, Zeluff, or Brundin, Applicants traverse this rejection, at least for the following reasons.

Applicants incorporate their above arguments with regard to claims 1, 19 and 37 and Vancillie, *supra*, as well as their above arguments with regard to Zeluff, *supra*. Because Vancillie and Zeluff teach away from one another, and because Brundin does not teach that which is lacking from Vancillie and Zeluff, and because claims 9, 10, 27, 28, 45 and 46 depend from allowable amended independent claims 1, 19 and 37, Applicants respectfully assert that claims 9, 10, 27, 28, 45 and 46 are allowable over Vancillie, Zeluff, and Brundin and request that this rejection be withdrawn.

Conclusion

In light of the above Remarks, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If the Office should have any questions or other issues to discuss, please do not hesitate to contact the undersigned attorney.

Applicants believe a two month extension of time fee is required. Please consider this a request for a two month extension of time and charge Deposit Account No. 50-2855 accordingly. Any deficiency or overpayment may also be applied to Deposit Account No. 50-2855.

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Respectfully submitted,

  
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